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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,216	07/20/2000	PETER FICKEISEN	193413USOPCT	2523
22850	7590	05/18/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 05/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/582,216	Applicant(s) FICKEISEN ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52, 54, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-14, 16-25, 28, 36-51 and 54 is/are allowed.
- 6) ☒ Claim(s) 26, 31, 32, 52, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' amendment filed 2/23/04 overcomes the rejections of record.

In light of the new grounds of rejection as set forth below, the following action is non-final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31-32 and 57-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 31 and 57 are drawn to a method of bonding a substrate comprising applying an aqueous composition to said substrate and "bonding the substrate to a carrier". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "bonding the substrate to a carrier" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

In the amendment filed 6/29/01, applicants point to original claim 7 and page 7, lines 26 and 37-39 of the present specification for support for the recitation of the above cited phrase. However, original claim 7 and page 7, line 26 of the specification only disclose that the aqueous composition is used as a floor adhesive while page 7, lines 37-39 of the present specification only discloses applying adhesive to substrate by a toothed applicator after which floor covering is installed. However, there is no support in either original claim 7 or page 7 for the recitation that the substrate is bonded "to a carrier".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 26, 31-32, 52, and 57-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 26 recites that the "method as claimed in claim 9 further comprises at least one component selected from the group consisting of a wetting agent, a dispersant, a defoamer, and a preservative". The scope of the claim is confusing because it is not clear how the "method" not the composition further comprises a wetting agent, a dispersant, a defoamer, and a preservative. It is suggested that the above phrase be re-written as "method as claimed in claim 9 wherein the aqueous composition further comprises at least one component selected from the group consisting of a wetting agent, a dispersant, a defoamer, and a preservative".

Similar change is suggested for claim 52 which recites similar claim language as claim 26.

(b) Claims 31 and 57 each disclose bonding the substrate to a "carrier". The scope of each of the claims is confusing because it is not clear what is meant by "carrier" or what types of materials are encompassed by this phrase.

Allowable Subject Matter

6. Claims 9-14, 16-25, 28, 36-51, and 54 are allowable over the "closest" prior art Kawashima et al. (U.S. 4,972,000) for the following reasons:

Kawashima et al. disclose an aqueous solvent-free coating composition comprising filler, dispersant, and polymer with insolubles, i.e. gel content, of 20-90% and number average molecular weight of the THF-soluble fractions of 700-20,000 wherein the polymer comprises 0.5-100% alkyl (meth)acrylate such as methyl (meth)acrylate, ethyl (meth)acrylate, and butyl (meth)acrylate and additional monomers including 0-99.5% styrene, (meth)acrylamide, and vinyl ester of organic acid and 0.5-88% (meth)acrylic acid. The polymer is present in the form of an aqueous dispersion with solids content of 10-65%. However, there is no disclosure in Kawashima et al. of method of adhering a floor covering comprising applying the aqueous composition to the floor covering and installing the floor covering as required in present claims 9-14, 16-25, 28, 36-51, and 54.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
5/14/04